



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
Schnell *et al.*

Serial No: 09/831,290

Filed: May 8, 2001

For: Method for Identifying Inhibitors of
IPC Synthase

Attorney Docket No. ASZD-P01-429

(formerly P 279455)

Art Unit: 1636

Examiner: Daniel M. Sullivan

#12

RECEIVED

FEB 03 2003

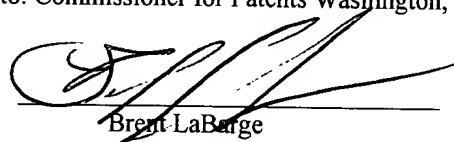
CERTIFICATE OF MAILING UNDER 37 C.F.R. §1.8(a)

TECH CENTER 1600/2900

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail, postage prepaid, in an envelope addressed to: Commissioner for Patents Washington, D.C. 20231 on the date indicated below:

January 23, 2003

Date of Signature
and of Mail Deposit


Brent LaBerge

Commissioner for Patents
Washington, D.C. 20231

REPLY TO RESTRICTION REQUIREMENT

Sir:

In reply to the outstanding Restriction Requirement, mailed on September 23, 2002, in connection with the above application, Applicants hereby elect with traverse Group I, e.g., claims 1-6, drawn to a screening assay and cells for identifying a selective IPC synthase inhibitor. Applicants elect this invention with traverse, because claim 7 encompasses overlapping subject matter, namely a selective IPC synthase inhibitor identified using the method and cells of claims 1-6. Accordingly, Group I-II could be examined simultaneously without significant additional burden.

Applicants note that claim 1 is a generic claim linking elected and non-elected species. Claim 7 is a dependent claim of claim 1, including all limitations of the generic claim 1. Pursuant to MPEP 809.04, "[i]f a linking claim is allowed, the examiner must thereafter examine species if the linking claim is generic thereto, or he or she must examine the claims to the non-elected inventions that are linked to the elected invention by such allowed linking claim." Thus,

restrictions imposed on species encompassed by generic claims must be withdrawn upon indication of an allowable generic claim (MPEP 809). In other words, upon the allowance of a generic claim, Applicants are entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141 (MPEP 809.02(a)).

Furthermore, the burden is on the Examiner to examine these generic claims throughout their scope, together with any claims dependent thereon drawn to non-elected species or inventions, rather than for Applicants to limit the scope of the generic claims to conform to the scope of any species or inventions listed in a Restriction Requirement.

The Examiner may address any questions raised by this submission to the undersigned at 617-951-7000. Should an extension of time be required, Applicants hereby petition for same and request that the extension fee and any other fee required for timely consideration of this submission be charged to **Deposit Account No. 18-1945**.

Date: January 23, 2003

Customer No: 28120
Docketing Specialist
Ropes & Gray
One International Place
Boston, MA 02110
Phone: 617-951-7000
Fax: 617-951-7050

Respectfully Submitted,



David P. Halstead
Reg. No. 44,735